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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,795	09/11/2000	Charles A. Lemaire	750.006US1	4145
21186	7590	06/13/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			PARDO, THUY N	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,795

Applicant(s)

LEMAIRE ET AL.

Examiner

Thuy Pardo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-16 and 18-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-16 and 18-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's Response to Examiner's Office Action filed on March 30, 2006 has been reviewed. Claims 1-9 and 17 have been canceled.

1. Claims 10-16 and 18-37 are presented for examination.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10-15 and 30-34 are rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson et al. (Hereinafter "Anderson") U.S. Patent Application No. 2004/0158524.

As to claim 10, Anderson teaches the invention substantially as claimed, comprising:

receiving a plurality of transactions for the database system including a first transaction from a service provider 0026] and a second transaction from a service consumer [0033], wherein the first and the second transactions are each associated with the service consumer [ab; 0003].

storing the plurality of transactions into the database system [database server 36 of fig. 1];

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selectively enabling access by the service consumer [customer can review transactions or wish to submit payments electronically, 0004-0005; 0033], based on an identification of the service consumer [account # and authorization code, 92 of fig. 4; 0016], to the stored first and second transactions associated with the service consumer to whom access is enabled [stored in database server 36 of fig. 1]; and

accessing the stored first and second transactions associated with the service consumer to whom access is enabled, the accessing being performed by the service consumer to whom access is enabled [customer can review transactions or wish to submit payments electronically, 0004-0005; 0033].

As to claim 11, Anderson teaches the invention substantially as claimed. Anderson further teaches receiving transactions by a docketing provider [ab].

As to claim 12, Anderson teaches the invention substantially as claimed. Anderson further teaches viewing a log of pending action items [0003-0006].

As to claim 13, Anderson teaches the invention substantially as claimed. Anderson further teaches that the service consumer uses a browser to access the stored transactions [0003-0006].

As to claim 14, all limitations of this claim have been addressed in the analysis of claim 10 above, and this claim is rejected on that basis.

As to claim 15, all limitations of this claim have been addressed in the analysis of claim 11 above, and this claim is rejected on that basis.

As to claims 30-31, Anderson teaches the invention substantially as claimed. Anderson further teaches receiving an electronic message [receive reports, 0029-0030] and decoding the transaction from the electronic message [user must enter the authorization code to view the report, 0027-0031], encoding the transaction into an electronic message and transmitting the electronic message [credit and debit transactions are encoded with Account #, Merchant #, authorization code...etc, 0027-0034; 90-94 of fig. 4].

As to claims 32-34, Anderson teaches the invention substantially as claimed. Anderson further teaches receiving transactions by a docket provider [financial service provider, 0029], viewing a long pending action items [0034], and using a browser to access the stored transaction [0026; 0034].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16, 18-29 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (Hereinafter "Anderson") US Patent Application No. 2004/0158524, in view of Whitmyer, Jr., US Patent Application No. 2002/0029215.

As to claims 18 and 35, Anderson teaches the invention substantially as claimed, with the exception that the information is regarding to a patent application and a service provider is associated with an intellectual property lawyer. Whitmyer teaches the information is regarding to a patent application [ab; 0015] and a service provider is associated with an intellectual property lawyer [IP Office, 32 of fig. 2]. Therefore, it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to add this feature to Anderson's system as an essential means to provide an efficient way of transferring patent documents to and from necessary intellectual property recordation authorities.

As to claim 16, all limitations of this claim have been addressed in the analysis above, and this claim is rejected on that basis.

As to claim 23, Anderson teaches the invention substantially as claimed. Anderson further teaches an input device that obtains a database transaction [inherent in the system]; an encoder that inserts the transaction into an electronic message [90-94 of fig. 4].

As to claim 24, Anderson teaches the invention substantially as claimed. Anderson further teaches a database stored in the storage, the database holding data for a plurality of service consumers including the first service consumer and for the first service provider [48, 50, 52 of fig. 2]; and a database transaction processor operatively coupled to the receiver of database transaction information and to the storage [database servers, 36 of fig. 1].

As to claims 25-29, 36 and 37, all limitations of these claims have been addressed in the analysis of claims 11-13 above, and these claims are rejected on that basis.

#### ***Response to Arguments***

4. Applicant's arguments filed on April 04, 2006 have been fully considered but they are not persuasive for the following reasons:

Applicant argues that Anderson fails to teach transactions between the service provider and the service consumer. Examiner respectfully disagrees. Anderson teaches receiving transactions from a financial services provider [0026] and transactions from the service consumer/customer [customer can review transactions or wish to submit payments electronically, ab; 0003-0005; 0033]. Applicant argues that the term "transaction" in the application is different to the term "transaction" in Anderson. As to this point, Examiner respectfully disagrees. Transactions in Anderson includes financial transactions and reports for user's current month's statement received in electronic mail [fig. 5; 0032] as same as the definition of the term "transaction" in the Specification of the Application in which a database transaction is an action object that is transmitted as electronic mails between source and destinations [see page 13, lines

2-21]. Furthermore, the features of an e-mail including the transaction object and extracting a database transaction from an electronic mail have not been disclosed in the independent claims.

Applicant argues that there is no indication that the described invention of Anderson would or could accept a transaction from a customer for adding or modifying information in a database.

As to this point, Examiner respectfully disagrees. Examiner believes that Anderson teaches this feature. User not only can view credit and debit card transactions but also can manipulate their own financial data [see 0033-0034].

Applicant argues that there is no description that the system would or could receive a second transaction from a service consumer.

Examiner respectfully disagrees. This feature is inherent in the system since Anderson teaches that users may manipulate their own financial data. Users can check their account balances, transfer funds between their own accounts...etc. and of course there must be more than one transactions between the user and the service provider.

Applicant argues that this is not a database to support a patent application service provider.

As to this point, Examiner respectfully disagrees. A database system for transactions between users and their service providers are wellknown and it can be applied in many exclusive operations, such as on-line banking, shopping in Internet, and in a patent application system as well. This is only a matter of a design choice. Moreover, Examiner also introduces the Whitmyer's system for transferring intellectual property over the Internet.

Applicant argues that Whitmyer does not suggest that an attorney involved in its system.



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Examiner respectfully disagrees. Again, Examiner believes that this is only a matter of a design choice. Since Whitmyer teaches a system for transferring intellectual property transactions over the Internet. An attorney for the inventor is inherent in the system in order to handle legal matters with the proper preparation and prosecution of patent transactions.

Examiner believes that Whitmyer is qualified as a prior art since its provisional application filed on July 09, 1999 is earlier than Applicant's application filed on September 11, 2000. Examiner will provide the references to Applicant as soon as it's received by examiner.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is 571-272-4082. The examiner can normally be reached Monday through Thursday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at 571-272-4146.

The fax phone number for the organization where this application or proceeding is assigned as follows:

571-273-8300 (Official Communication)

and/or:

571-273-4082 *(Use this Fax#, only after approval by Examiner, for "INFORMAL" or "Draft" communication. Examiner may request that a formal/amendment be faxed directly to then on occasions).*

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 09, 2006

A handwritten signature in black ink, appearing to be 'THUY N. PARDO', with a long, sweeping horizontal line extending to the right.

**THUY N. PARDO**  
**PRIMARY EXAMINER**